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T-D

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/323,230	06/01/99	UETANI	Y 2185-0343P

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EXAMINER

CHU, J

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 10/16/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/328,230

Applicant(s)
UETANI ET AL

Examiner
John Chu

Group Art Unit
1752



☒ Responsive to communication(s) filed on Sep 7, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-5 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-5 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

This Office action is in response to the amendment received September 7, 2000.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over TACHIKAWA ET AL.

The claimed invention is drawn to a positive resist composition which comprises a novolac resin, a radiation sensitive quinonediazide compound and a thioxanthone compound of formula (I).

TACHIKAWA ET AL discloses a photosensitive composition comprising a quinonediazide compound and a sensitizer wherein the sensitizers are disclosed in column 3, lines 3-15. Applicants are directed to line 12 for the suggestion of thioxanthone as an additive aromatic ketone.

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TACHIKAWA ET AL lacks an explicit example using the claimed and disclosed thioxanthone, however it would have been *prima facie* obvious to one of ordinary skill in the art of photosensitive quinonediazide containing compositions to use any of the listed aromatic ketones with the reasonable expectation of same or similar results as disclosed in TACHIKAWA ET AL for the formation of positive and negative images.

Motivation is based on the desire to have a composition which can function in a positive or negative manner as recited in TACHIKAWA ET AL.

The arguments by applicants have been noted, however example 1 is brought to the attention of applicants wherein the binder disclosed is a phenol resin at 2 parts by weight which is a well known m-cresol novolak resin (as disclosed in Suzuki et al '145, example 1, column 10, lines 35-36) .

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

SUZUKI ET AL '145 and NAMIKI ET AL disclose the commercial product defined as Sumitomo PR-50904 which is a phenol novolak resin.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after


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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Chu whose telephone number is (703) 308-2298. The examiner can normally be reached on Monday - Friday from 9:30 am to 6:00 pm.

The fax phone number for this Group is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.



John S. Chu
Primary Examiner, Group 1700

J.Chu
October 13, 2000